



PATENT

Attorney Docket Nos.: 00537/169002 and
073/US/PCT/US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF:

Zheng Xin DONG *et al.*

APPLICATION NO.: 09/674,597

FILED: April 9, 2001

FOR: **PTH2 RECEPTOR SELECTIVE
COMPOUNDS**

Mail Stop: Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

EXAMINER: **WEGERT, Sandra L.**

ART UNIT: 1647

CERTIFICATE OF MAILING

I hereby certify under 37 CFR §1.10 that this correspondence is being deposited with the United States Postal Service as Express mail EV 921127063 US with sufficient postage on the date indicated below and is addressed to the Commissioner of Patents, PO Box 1450, Alexandria, VA 22313-1450.

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6-29-2006
Alan F. Feeney
Alan F. Feeney, Esq.

Sir:

RESPONSE TO NOTICE OF NON-COMPLIANT AMENDMENT
(37 CFR §1.121)

In response to the Notice of Non-Compliant Amendment under 37 C.F.R. §1.121 mailed on February 6, 2006, the period for response there having been extended so as to expire on July 6, 2006 pursuant to Applicants' Petition for Extension of Time filed concurrently with this Reply, Applicants respectfully aver that the Reply Under 37 C.F.R. 1.111 mailed October 11, 2005 was proper and requests entry thereof. The reason provided for the refusal to enter Applicants' October 11, 2005 reply were "[a]pplicants may not withdraw claims to overcome rejections, such as claims 11, 12, 15, 25, 26 and 29 (Remarks, 10/12/05, page

23)...[and that] [c]laims should be canceled to remove them from further prosecution." A careful reading of Applicants' response would have indicated that claims 11, 12, 15, 25, 26 and 29 were withdrawn from consideration in response to the restriction requirement imposed by the Examiner. As noted in the Office Action mailed May 14, 2004, the Examiner, at page 2 thereof, stated that claims 1-3, 7, 9-15 and 23-29 [were] under examination" having withdrawn claims 4-6, 8, 16-22 and 30-47 from consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Invention. In an Office Action mailed April 11, 2005, the Examiner rejected claims 1-3, 7, 9-15 and 23-29 as being drawn to unelected subject matter. In the rejected reply at page 24, paragraph 5, Applicant withdrew claims 11, 12, 15, 25, 26 and 29 in response to the restriction requirement arguing the impropriety thereof and requesting rejoinder thereof. As such, Applicants contend that withdrawing said claims was not done to overcome a substantive rejection, but in response to an improper and legally unsupported restriction requirement, however, in an effort to be responsive, Applicants herein amend claims 9-14, rescind the withdrawal of claims 15, 25, 26 and 29 and add new claims 48-51.

Applicants respectfully request the entry of the below amended claims set with revised remarks.

The present amendments follow the revised amendment practice mandated by 37 C.F.R. 1.121 effective July 30, 2003.

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Claims pending in the application are listed on pages **4-25**
of this paper.

Applicant's Remarks begin on page **26** of this paper.